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08/594,195

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| 08/594,195 | 01/31/96 | TAKABATAKE | A | 394-1969 |

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| EXAMINER | |
|---|---|
| LEE, Y | |
| ART UNIT | PAPER NUMBER |
| 2615 | 8 |

DATE MAILED: 04/15/97

**Please find below a communication from the EXAMINER in charge of this application.**

Commissioner of Patents

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 08/594,195 | Akihiko Takabatake et al |
| **Examiner** | **Group Art Unit** |
| Y. Lee | 2615 |

☒ Responsive to communication(s) filed on *Mar 25, 1997* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) *1-26* is/are pending in the application.

Of the above, claim(s) *4-7, 11-13, 15, 18-20, and 24-26* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-3, 8-10, 14, 16, 17, and 21-23* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---*

**Part III DETAILED ACTION**

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

*Claim Rejections - 35 USC § 112*

2. Claims 1-3, 14, 16, 17, and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the same reasons as set forth in paragraph 7 of the last office action, paper number 6, dated 1/23/97.

With respect to Applicant's argument on pages 6 and 7 of the Remarks, claims 1-3, 14, 16, 17, and 21-23 stand rejected because they are directed to different embodiments of the present invention other than Applicant's elected species 2 (see MPEP 821). For example, as admitted by the Applicant, claim 1 requires a one field time difference between the decoding start timing and the reading out for B picture. This is clearly distinguished from the elected embodiment 2, which requires a one macro block line delay. It is true that there is nothing wrong with having independent claims broader in scope than the elected embodiment as long as each is readable thereon. However,

claims 1, 14, and 21 are not readable on species 2 and therefore they are not generic claims.

With respect to Applicant's argument on page 7 of the Remarks, claims 2 and 3 may appear to recite similar limitations that are directed to embodiment 2. However, Applicant is reminded that dependent claims 2 and 3 include all of the limitations of the independent claim 1, which are directed to a different species of the invention. Examiner did not misinterpret claim 1 because of the limitations in claim 2. The rejection is solely based on the fact that claim 1 is directed to a different embodiment other than species 2 of the present invention.

Similarly, regarding Applicant's argument on page 8 of the Remarks, claim 14 is also directed to an embodiment that is different from Applicant's elected species 2. The pull-down conversion of claim 14 may have been "naturally developed from embodiment 2" or "a modification of embodiment 2" as Applicant admits. The fact remains that claim 14 is directed to a different species of the invention because Applicant's elected species 2 is not directed to pull-down conversions and/or any modifications.

Finally, for the same reasons, claim 21 appears to be directed to embodiment 1 or 4, but it is certainly not readable on Applicant's elected species 2.

With respect to the argument on pages 8-9, Applicant seems to have misunderstood the entire restriction process as specified in paper number 4, dated 12/9/96. Applicant is reminded that they are required under 35 U.S.C 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted. It is true that a claim is allowed to cover a plurality of embodiments in a generic form. However, none of the claims in question, namely 1, 14, and 21, read on Applicant's elected species 2. Claims 1, 14, and 21 may have been generic to several other embodiments (i.e., readable on more than one species), but the fact remains that they are not readable on Applicant's elected species 2.

With respect to Applicant's argument on page 9 of the Remarks, claims 5-7 were withdrawn from further consideration by the examiner as being drawn to a non-elected species in paragraph 2 of the previous office action, paper number 6, dated 1/23/97. Therefore, the scope of these claims have not been considered by the Examiner.

## *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 8-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Auld for the same reasons as set forth in the previous office action, paper number 6, dated 1/23/97.

Auld, in Figures 2-6, discloses a channel buffer in video decoders that is the same picture decoding and display unit for decoding predictively encoded pixel data (I,P,B) of a picture included in an incoming bit stream 21 as specified in claims 8-10 of the present invention, for restoring original pixel data 22 and outputting the restored original pixel data 22 for display on a display unit 34, the picture formed by a frame of a plurality of fields (Fig. 5), the picture decoding and display unit comprising decoding means 28 coupled to receive the bit stream 21, for carrying out the decoding processing on the predictively encoded pixel data (I,P,B) to restore the original pixel data 22; storage means 24 coupled to the decoding means 28, for storing the restored pixel data 22 received from the decoding means 28; read means 32 coupled to the storage means 24, for reading pixel data from the storage means 24 for outputting the display unit 34 for display thereon; and control means 36 coupled to the read means 32 and the decoding means 28 for making the decoding means 28 start decoding processing of pixel data of a subsequent frame supplied subsequently to a certain frame

including a last field to be finally displayed in the certain frame in response to reading of the last field (video buffer verifier) from the read means 32, the subsequent frame supplied immediately following a picture having the decoding processing 28 thereon completed upon the reading of the last field 32.

With respect to claim 9, the decoding processing of Auld is carried out in units of blocks of the pixel data of prescribed sizes on a screen, the picture including M blocks in a horizontal direction on the screen (col 3, lines 17-35 and col. 5, lines 28-39), the control means 36 further including delay means (Vbv Delay) for delaying the timing for starting the decoding processing of the decoding means 28 by a time required for reading the pixel data of the M blocks from the storage means 24.

With respect to claim 10, the delay means (Vbv Delay) of Auld includes buffer memory means 50 arranged between a pixel data output part of the storage means 24 and an output port of the read means 32 coupled to the display unit 34, for storing the pixel data received from the storage means 24 for a prescribed time.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

*Response to Amendment*

6. Applicant's arguments filed 3/25/97 have been fully considered but they are not deemed to be persuasive.

In response to Applicant's argument that Auld does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., (1) the time relationship holds for both I and B pictures; (2) I3 picture is decoded during the periods T1 and T2, and the decoded I3 picture is stored during the periods T3-T7 and then transferred for display during the period T8; and (3) I/P pictures are not overlapped in decoding and reading operation thereof) are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

With respect to Applicant's argument on page 11 of the Remarks, column 14, line 2 of Auld merely discloses one of the many embodiments. In column 9 however, Auld also discloses the newly amended claim 8 wherein the subsequent frame supplied immediately following a picture having the decoding processing 28 thereon completed upon the reading of the last field (bits required to reconstruct a single picture).

*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

TOMMY P. CHIN
SUPERVISORY PATENT EXAMINER
GROUP 2600

Y. Lee/yl
April 7, 1997